

REMARKS

Claims 1, 3, and 5-22 are pending in the Application. All of those claims were rejected in the April 16 Final Office Action. No claims are amended by this response. Claims 1 and 15 are independent claims, while claims 3 and 5-14 depend from claim 1, and claims 16-22 depend from claim 15.

The Applicant respectfully requests reconsideration and allowance of claims 1, 3, and 5-22, in light of the following remarks.

Previous Rejection of Claims Under 35 U.S.C. §112

In a prior Office Action mailed October 31, 2007, certain claims were rejected under 35 U.S.C. §112. Applicant notes that no claims were rejected under 35 U.S.C. §112 in the April 16, 2008, Office Action, and appreciates the reconsideration of that rejection from the previous Office Action.

Rejection of Claims Under 35 U.S.C. §102

The April 16, 2008, Final Office Action rejected claims 1, 3, and 5-22 as being anticipated by O'Neil, U.S. Patent No. 6,832,373 (hereinafter "O'Neil"). Without conceding the applicability of O'Neil as a §102(e) reference, Applicant respectfully traverses those rejections, and requests reconsideration of those rejections, for at least the following reasons:

- O'Neil does not disclose "a shift region list that identifies at least one region of the first version of firmware and an associated offset";
- O'Neil does not disclose "wherein the first version is modified to correspond with the shift region list in the update package"; and,

- O'Neil does not disclose "the encoded difference information is generated to comprise the differences between the second version and the **modified first version**."

Independent claim 1 recites, *inter alia*, "a generator for generating an update package used in updating firmware in the mobile electronic device from a first version to a second version, the update package comprising encoded difference information and a shift region list that identifies at least one region of the first version of firmware and an associated offset, wherein the first version is modified to correspond with the shift region list in the update package, and the encoded difference information is generated to comprise the differences between the second version and the modified first version."

Applicant notes that claim 1 thus requires, *inter alia*, "a shift region list that identifies at least one region of the first version of firmware and an associated offset." Claim 1 further requires "wherein the first version is modified to correspond with the shift region list in the update package." Claim 1 further requires that "the encoded difference information is generated to comprise the differences between the second version and the modified first version." Claim 1 can be anticipated by O'Neil only if each and every element as set forth in the claim is found in O'Neil. See MPEP §2131.

As an initial matter, Applicant respectfully submits that O'Neil does not teach "a shift region list that identifies at least one region of the first version of firmware and an associated offset." The Office Action asserted that O'Neil disclosed "the update package comprising encoded difference information and a shift region list that identifies at least one region of the first version of firmware and an associated offset" at column 3, line 63 to column 4, line 25. That portion of O'Neil states:

In one embodiment the invention comprises a system for updating a plurality of distributed electronic devices with an updated operating code comprising a first plurality of digital information sequences wherein each of the plurality of electronic devices include a resident operating code comprising a second plurality of digital information sequences that are stored within the electronic device. The

system further comprises an update generator that compares an image of the first plurality of digital information sequences comprising the updated operating code to an image of the second plurality of digital information sequences comprising the resident operating code and identifies differences between of [sic] the updated operating code and the resident operating code and thereafter generates an update package comprising an instruction set which specifies how to generate the updated operating code utilizing at least a portion of the second plurality of digital information sequences of the resident operating code. The system further comprises a distribution system that distributes the update package to the electronic devices such that the update package is received by the electronic devices and stored therein. The system further comprises a plurality of client modules that are respectively resident on each of the plurality of electronic devices, wherein the plurality of client modules access the distribution system and receive the update package and wherein the instruction set of the update package is executed by the client modules so as to generate the updated operating code by utilizing a [sic] least a portion of the second plurality of digital information sequences from the resident operating code.

(emphasis added). Thus, O'Neil discloses "an image of the first plurality of digital information sequences comprising the updated operating code." O'Neil also discloses a "second plurality of digital information sequences comprising the resident operating code." Then, the cited embodiment of O'Neil "identifies differences between of [sic] the updated operating code and the resident operating code and thereafter generates an update package comprising an instruction set which specifies how to generate the updated operating code utilizing at least a portion of the second plurality of digital information sequences of the resident operating code." (emphasis added). Thus, as will be discussed in greater detail below, O'Neal discloses identifying differences between a resident operating code and the updated operating code. The portion of O'Neill shown above, which was specifically cited by the Office, does not disclose modification of a first version of firmware to correspond with a shift region list, and further does not disclose generating encoded difference information comprising the differences between a second version and the modified first version.

The Office Action stated that “shift region and offset correspond to O’Neil’s use of and instructions for how to use existing code, ‘second plurality of digital information sequences’ of the resident code.” Applicant respectfully submits that the disclosure of “use of and instructions for how to use existing code” does not provide sufficient detail or description to disclose a shift region list, let alone a shift region list that identifies at least one region of the first version of firmware and an associated offset. As such, Applicant respectfully submits that the above cited portion of O’Neil does not disclose “a shift region list that identifies at least one region of the first version of firmware and an associated offset,” and that O’Neil cannot anticipate claim 1, or any claim dependent from claim 1, for at least that reason. (See MPEP §2131: “‘The identical invention must be shown in as complete detail as is contained in the...claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).”)

Moreover, claim 1 also requires “wherein the first version is modified to correspond with the shift region list in the update package.” As the cited portion of O’Neil does not disclose a shift region list, from above, this portion of O’Neil cannot disclose wherein the first version is modified to correspond with a shift region list. Applicant respectfully submits that O’Neil does not anticipate claim 1 or its dependent claims for at least that reason as well.

Additionally, from above, claim 1 recites a generator for generating an update package used to update firmware from a first version to a second version, wherein the first version is modified to correspond with the shift region list, and the update package comprises difference information between the second version and the modified first version. Thus, claim 1 recites three different versions of the firmware: a first version (from which it is updated), a modified first version, and a second version (to which it is updated). Further, the “difference information” of claim 1 is difference information “between the second version and the modified first version.”

The cited portion of O’Neil, on the other hand, does not disclose a modified first version, let alone difference information between the modified first version and second

version. In asserting that O'Neil disclosed "wherein the first version is modified to correspond with the shift region list in the update package, and the encoded difference information is generated to comprise the differences between the second version and the modified first version," the Office Action cited column 3, line 63 – column 4, line 25 (the same portion of O'Neil quoted above). The Office Action stated that "encoded difference information corresponds to new information that must be added or removed from the original, 'a first plurality of digital information sequences' from the updated operating code."

Applicant submits that the disclosure of O'Neil -- even as interpreted by the Office Action -- does not disclose the difference information as claimed in claim 1. For example, the Office Action asserted that O'Neil disclosed difference information "that must be added or removed from the original, 'a first plurality of digital information sequences' from the updated operating code." (emphasis added). The difference information of claim 1, however, is not between the original and updated version. Instead, in claim 1, "the encoded difference information is generated to comprise the differences between the second version and the **modified** first version."

The portion of O'Neil cited in the Office Action further illustrates that distinction. For example, at column 4, lines 6-13, O'Neil states that its update generator "identifies differences between of [sic] the updated operating code and the resident operating code and thereafter generates an update package comprising an instruction set which specifies how to generate the updated operating code utilizing at least a portion of the second plurality of digital information sequences of the resident operating code." O'Neil thus identifies differences between the updated operating code and the resident operating code, and not differences between updated operating code and a modified first version. The cited portion of O'Neil does not disclose a first version modified to correspond with a shift region list, let alone encoded difference information generated to comprise the differences between the second version and the modified first version.

The Office Action further stated that “further difference information is found [at] column 21, lines 25-40, literal information incorporated.” That portion of O’Neil states:

A threshold of efficiency is used to insure that the identified “best result” is at least as efficient or more efficient than a default instruction function comprising incorporating the literal string directly into the update package 110. If the identified best result function is more efficient than the default instruction then the instruction coding for the information sequence coded by the comparison function is incorporated into the update package 110 and the pointer is updated to the first section of information immediately following the code translated by the comparison function in a state 412. Otherwise, if the default instruction is determined to be more efficient than the “best result” function, then the default instruction is included in the update package 110 in state 414 and the pointer updated in a similar manner in state 412.

As with the above discussion, Applicant respectfully submits that nothing in the cited portion discloses a first version modified to correspond with a shift region list, let alone encoded difference information generated to comprise the differences between the second version and the modified first version. As such, Applicant submits that the cited portion of O’Neil does not disclose “the encoded difference information is generated to comprise the differences between the second version and the modified first version” as claimed in claim 1, and therefore cannot anticipate claim 1 or its dependent claims.

Claim 15 recites a method comprising, *inter alia*, “creating a shift region list that identifies at least one region of the first version of firmware and an associated address adjustment” and “generating encoded difference information that comprises differences between the first version that is modified to correspond to the shift region list and the second version.” Thus, Applicant respectfully submits that claim 15, and the claims that depend therefrom, are also allowable for at least the same reasons discussed above in connection with claim 1.

Applicants respectfully note, should the Office consider a future rejection of the pending claims under 35 U.S.C. 103(a) in view of O'Neill, that in accordance with 35 U.S.C. 103(c), O'Neill is not a valid reference under 35 U.S.C. 103(a), because the present application and O'Neill (U.S. Patent No. 6,832,373) were, at the time the invention was made, owned by, or under a common obligation to assign ownership to Bitfone Corporation.

Conclusion

In general, the Office Action makes various statements regarding claims 1, 3, and 5-22 and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of claims 1, 3, and 5-22 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to contact the undersigned at (312) 775-8000 for an interview.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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